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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/685,601

10/11/2000

Franco Lo Giudice

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07/12/2005

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,601

Applicant(s)

GIUDICE ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13,15 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 30-33 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13,15 and 17-29 is/are rejected.
- 7) ☒ Claim(s) 2,15 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

The amendment filed August 19, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. There is no basis in the original disclosure for the addition of the phrase "number average" to the description of the molecular weight of the polysiloxane component. Indeed, insofar as Applicant had not expressly disclosed whether the molecular weight associated with this component was a number-average molecular weight or a weight-average molecular weight, the only way Applicant's amendment to the Specification could be supported would be if, for instance, Applicant had identified elsewhere in the disclosure a commercially available product that was exemplary of this material for which it could have been demonstrated that the molecular weight recited was, in fact, number average molecular weight. Unfortunately, there appears to be no specific embodiments mentioned hence the original disclosure would appear to lack support for this limitation. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claim 2 is objected to because, insofar as it is an independent claim, the article "The" at the beginning of the claim should be replaced with "A".

Claim 15 is objected to because claim 3 is not directed to an organic polymer but, rather, a composition containing an organic polymer. Removal of this phrase from the beginning of claim 15 is required.

Claim 17 is objected to because there is a period in the middle of the sentence.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 9-13, 15, and 17-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As before, the original disclosure does not properly support Applicant's new limitation that the molecular weight associated with the polysiloxane component is a number-averaged molecular weight.

Claim 7 also introduces new matter because Applicant has amended the language such that it now indicates that the weight contribution of the hydrocarbon is 0.1 to 50 wt.% as a fraction of the combined weight of said hydrocarbon and the organic polymer. This is to be contrasted with the original language which stated that the aforementioned contribution was expressed as a fraction of the combined weight of the organic polymer and the *additive composition* which, of course, includes a polysiloxane. Correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Concerning claim 10, it is not clear what it means for the additive composition to be "supported by" a polymer matrix. Clarification is requested.

Regarding claim 22, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Allowable Subject Matter

Claims 1-7, 9-13, 15, and 17-29 would be allowable if rewritten or amended to overcome the various objections/rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action. The Examiner agrees with Applicant's analysis of the shortcomings of the prior art in view of the amendments made of record. No references more germane than those already recited have been found. Claims 30-33 are allowable.

As an aside, the Examiner sincerely apologizes for the long delays in the prosecution of this case. For reasons unknown to me, the case had been recorded, once again, as being lost as of the date that Applicant's August 2004 amendment was filed. The case was not forwarded to the Examiner for further action until approximately 6 weeks ago.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 6, 2005

Marc Zimmer
Marc Zimmer
AV 1712